

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

UNIVERSITY OF MASSACHUSETTS
and CARMEL LABORATORIES LLC,

Plaintiffs,

V.

L'ORÉAL USA, INC.,

Defendant.

C.A. No. 17-868-CFC-SRF

PUBLIC VERSION

**MOTION NO. 2: L'ORÉAL USA'S REPLY BRIEF IN SUPPORT
OF ITS MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS
OF THE SKIN ENHANCEMENT CLAIM LIMITATION**

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Dated: October 16, 2020

TABLE OF CONTENTS

	Page
I. Introduction.....	1
II. Plaintiffs Misstate the Claim Construction Record	1
III. Plaintiffs Ignore the Necessity of Skin Enhancement to the Claims.....	2
IV. The “Enhance the Condition of the Skin” Language Is Indefinite.....	4
V. Conclusion	6

TABLE OF AUTHORITIES

Page(s)

Cases

In re Cruciferous Sprout Litig.,
301 F.3d 1343 (Fed. Cir. 2002)3

Dow Chem. Co. v. Nova Chem. Corp. (Canada),
803 F.3d 620 (Fed. Cir. 2015)6

HZNP Med. LLC v. Actavis Labs. UT, Inc.,
940 F.3d 680 (Fed. Cir. 2019)2, 3

TABLE OF EXHIBITS¹

Exhibit No.	Document
1	U.S. Patent No. 6,423,327, issued to Dobson, Jr. et al. on July 23, 2002
5	Declaration of Gerald B. Kasting, Ph.D., containing true and correct excerpts from the Expert Report of Professor Gerald B. Kasting, Ph.D., dated June 26, 2020
12	Excerpts from the Rebuttal Expert Report of Bozena Michniak-Kohn, Ph.D. Regarding Validity, dated July 21, 2020
17	Excerpts from the deposition transcript of James Dobson, taken May 27, 2020
18	Defendant's Exhibit 1, entered during the deposition of James Dobson, taken May 27, 2020
24	Excerpts from the prosecution history of U.S. Application No. 09/672,348 (later issued as U.S. Patent No. 6,423,327)
33	Excerpts from the Claim Construction hearing transcript, dated April 6, 2020
44	Excerpts from the deposition transcript of Bozena Michniak-Kohn, Ph.D., taken August 18, 2020, portions of which were previously submitted as Exhibit 22
45	Excerpts from Plaintiffs' First Supplemental Responses and Objections to Defendant's First Set of Interrogatories, dated May 1, 2020, portions of which were previously submitted as Exhibit 30
47	Email chain between counsel for Plaintiffs and counsel for L'Oréal USA, dated December 27, 2019

¹ "Ex. __" refers to exhibits attached to the Declaration of Nicholas A. Tymoczko in Support of L'Oréal USA, Inc.'s *Daubert* and Summary Judgment Motions (D.I. 286), containing Exhibits 1-38, and the Second Declaration of Nicholas A. Tymoczko in Support of L'Oréal USA, Inc.'s *Daubert* and Summary Judgment Motions, submitted herewith, containing Exhibits 39-49.

Citations to "RSOF" refer to Plaintiffs' Responsive Concise Statement of Facts. (D.I. 319.)

Exhibit No.	Document
49	Excerpts from the parties' Joint Claim Construction Brief (D.I. 97), filed March 6, 2020, portions of which were previously submitted as Exhibit 32

I. INTRODUCTION

Plaintiffs do not dispute that multiple methods may be used to assess whether skin condition has been enhanced, as required by the claims, and do not even address that such assessment may be purely subjective according to the patents-in-suit. Instead, they mischaracterize L'Oréal USA's motion as an attempt to relitigate claim construction, ignore that the issues presented by the instant motion were not previously before or decided by the Court, and then ask the Court to give force to only selective portions of the claims. Those arguments fail. Plaintiffs cannot avoid the claims' plain language: the method requires enhancing the condition of the skin. And because the scope of this requirement is not reasonably certain, the patents-in-suit are indefinite.

II. PLAINTIFFS MISSTATE THE CLAIM CONSTRUCTION RECORD

Plaintiffs are wrong that the Court previously decided whether the claim language “topically applying to the skin a composition comprising a concentration of adenosine in an amount *effective to enhance the condition of the skin without increasing dermal cell proliferation*” satisfies the definiteness requirement. The only issue at *Markman* was the construction of “wherein the adenosine concentration applied to the dermal cells is [numerical range],” and that is all the

Court’s Order addressed. (Ex. 49 at 1; D.I. 114.)² The different claim language implicated by this motion was not proposed for construction and was not before the Court. (*Compare* Ex. 1, 10:21-24, *with id.*, 10:25-26.) Plaintiffs quote the Court’s reference during *Markman* to the overall structure of the claim (Ex. 33 at 56:19-57:24) to argue otherwise, but the Court did not analyze—much less decide the definiteness of—the “enhance the condition of the skin” language.

III. PLAINTIFFS IGNORE THE NECESSITY OF SKIN ENHANCEMENT TO THE CLAIMS

Plaintiffs try to have it both ways when they argue that other wording within that same claim phrases (“without increasing dermal cell proliferation”) is limiting. (D.I. 310 at 11-12; *see also* Ex. 45 at 27, 29, 31-32.) The patentee cannot pick and choose which parts of its patents are limitations, and which are not, to suit its litigation desires.³ This claim language, which is in the body of the claim, cannot be rendered inconsequential, as Plaintiffs propose. *HZNP Med. LLC v. Actavis*

² Unless otherwise noted, all emphases have been added and all internal citations, modifications, and quotations have been omitted.

³ Indeed, Plaintiffs do not dispute that they previously proposed this term for construction, thereby acknowledging it as a limitation (even if this was done, as they suggest, in response to indefiniteness arguments). (Br. at 10.) Despite Plaintiffs’ insinuation to the contrary, the parties ultimately chose not to address indefiniteness during *Markman* because the issue is not what the words of the claims mean, but rather whether they reasonably inform their boundaries in light of the multiple measurement methods that can be used. (Ex. 47 at 2-3.)

Labs. UT, Inc., 940 F.3d 680, 692 (Fed. Cir. 2019) (“[C]laim language should not be treated as meaningless.”).⁴

Plaintiffs’ predictable, but incorrect, argument that the preamble is non-limiting fares no better. The language at issue is not just in the preamble, but also the claim body. (D.I. 279 at 9.) And Plaintiffs do not and cannot dispute they expressly identified this preamble language as a “limitation[]” (Ex. 45 at 31), but instead point to an ambiguous statement from an earlier response to the same interrogatory (Br. at 10). Even there, though, Plaintiffs made clear that this claim language was limiting by arguing that the prior art does “not disclose a *method of enhancing skin condition*.” (Ex. 45 at 27-28.) In any event, Plaintiffs conceded in their opposition that the preamble’s recitation of “unbroken skin” was used to distinguish the prior art during prosecution. (Br. at 6-7.) *See, e.g., In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1347 (Fed. Cir. 2002) (holding preamble language to be limiting when relied on “during prosecution to distinguish the claimed invention from the prior art”). That follows from Plaintiffs’ prosecution argument that the preamble was added to “mov[e] this application towards allowance,” *i.e.*, to obtain the patent, and Plaintiffs cannot now credibly argue that

⁴ Were it otherwise, 10^{-7} M adenosine could reach only the very top of the dermal cells for no more than a moment with no effect; but, according to Plaintiffs, that would constitute infringement. (Ex. 44 at 103:3-21, 108:9-109:8.)

only portions of the preamble are limiting. (Ex. 24 at CARMEL LABS_00000793.) This is especially true given that, in distinguishing the prior art, Plaintiffs stated that “Applicants apply adenosine as a cosmetic approach to enhance the condition or complexion of the skin.”⁵ (Ex. 24 at CARMEL LABS_00000796.)

IV. THE “ENHANCE THE CONDITION OF THE SKIN” LANGUAGE IS INDEFINITE

It is undisputed that the “enhance the condition of the skin” language is a term of degree, and that (1) the specification expressly allows for “subjective evaluations” as an alternative to objective methods and (2) Plaintiffs’ own named inventor confirmed that subjective assessments alone suffice. (RSOF, ¶¶ 5-8, 10.) Plaintiffs ignore these dispositive points in opposition, and the inquiry should end here. (*See* D.I. 279 at 6-7 and cases cited therein.)⁶

⁵ The unpublished Eastern District of Texas case cited by Plaintiffs (Br. at 10) is inapposite because there can be no argument that a concrete aspect of the method claims at issue here (*i.e.*, achieving enhanced skin condition) is simply the “environment” of the claimed method.

⁶ Plaintiffs purport to dispute that their expert has acknowledged that “a subjective assessment may be used to determine whether the condition of the skin has been enhanced” (RSOF, ¶ 9), but the sole paragraph of her report cited is silent with respect to subjective evaluations, and she did not challenge Dr. Kasting’s opinions regarding this issue. (*Compare* Ex. 5, ¶¶ 258-60, *with* Ex. 12, ¶¶ 181-88.)

Plaintiffs also do not dispute that there are multiple different methods for assessing the vague concept of whether skin “condition” has been “enhance[d].” (RSOF, ¶ 12.) Their argument that there is “no evidence” of “conflicting results” generated by these different methods (Br. at 11-12) is unsupported, since both Dr. Kasting and Dr. Dobson testified to the exact opposite. (Ex. 5, ¶¶ 259-62 (noting, *e.g.*, (1) that assessments are “liable to give conflicting results,” (2) the discrepancy between patient and investigator evaluations, and (3) that “given methods or tests may generate different results”); Ex. 17 at 171:1-15; SOF, ¶¶ 11-12; RSOF, ¶ 13.)⁷ Plaintiffs cite the patents-in-suit (RSOF, ¶ 11), but they make no claim (nor can they) that all the different permitted subjective and objective methodologies give the same outcome. They also cite: (1) paragraph 186 of Dr. Michniak-Kohn’s report (Ex. 12), but that too is silent on this point and thus cannot create a genuine issue of material fact; and (2) the *Markman* hearing transcript, which neither addressed the issue nor constitutes evidence. None of this can defeat summary judgment on the legal issue of indefiniteness.

Plaintiffs also argue that the patents-in-suit identify a method for measuring one of the parameters of skin condition (“fine lines and wrinkles”), but that does

⁷ Plaintiffs’ last-ditch effort to now disparage their own inventor (Br. at 11) is to no avail since he was also testifying as Plaintiffs’ Rule 30(b)(6) witness on these topics, and their expert acknowledged Dr. Dobson’s authority regarding this subject. (Ex. 17 at 37:14-38:5; Ex. 18 at 10 (No. 31); Ex. 44 at 126:3-9.)

not address the remaining parameters (roughness, dryness, or laxity). Indeed, Plaintiffs' expert acknowledged that other methods of assessing skin enhancement exist and did not opine that the patents-in-suit endorsed a particular method.

(*Compare* Ex. 12, ¶¶ 187-88 (“the asserted patents provide *flexibility* for the skilled artisan to select the desired assessment standard”), *with* RSOF, ¶ 14.) To be clear, the patents-in-suit in no way limit enhancing the condition of skin to one type of test, and explicitly state otherwise. (Ex. 1, 5:44-6:4.) This supposed “flexibility” that Plaintiffs have embraced, presented without guidance, only reinforces the indefiniteness of the patents-in-suit. *See Dow Chem. Co. v. Nova Chem. Corp. (Canada)*, 803 F.3d 620, 634-35 (Fed. Cir. 2015).

V. CONCLUSION

L'Oréal USA respectfully requests that the Court grant its motion.

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CERTIFICATE OF SERVICE

I hereby certify that on October 16, 2020, a true and correct copy of the foregoing document was filed with the Clerk of Court via CM/ECF which will send notification of such filing to counsel of record and I further certify that a true and correct copy of the foregoing document was caused to be served on the following counsel of record as indicated:

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION

The foregoing MOTION NO. 3: L'ORÉAL USA'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF ANTICIPATION complies with the type-volume limitations of Paragraph 19(c) of the Scheduling Order (D.I. 46). The text of this brief, including footnotes, was prepared in Times New Roman 14-point. According to the word processing system used to prepare it, this brief contains 1174 words, excluding the case caption, tables, and signature block. Defendant L'Oréal USA's *Daubert* and summary judgment reply briefs are a combined 6,227 words, excluding the case captions, tables, and signature blocks.

October 16, 2020

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